

## **REMARKS**

### **INTRODUCTION:**

In accordance with the foregoing, claims 38-54 have been canceled without prejudice or disclaimer, and claims 15 and 28 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-37 are pending and under consideration. Reconsideration is respectfully requested.

### **PROVISIONAL ELECTION OF CLAIMS PURSUANT TO 37 CFR §1.142:**

Claims 15 and 28 have been amended to depend from independent claim 1. Thus, it is respectfully submitted that claims 15-27 and 28-37 are now in Amended Group I. Applicants provisionally elect **Amended Group I (claims 1-37)** in response to the preliminary restriction requirement set forth in the Office Action.

### **APPLICANTS TRAVERSE THE REQUIREMENT:**

Since claims 15-27 and 28-37 have been incorporated into Amended Group I, it is respectfully submitted that claims 15-37 should be considered together with claims 1-14.

Claims 38-54 have been cancelled without prejudice or disclaimer. Thus, Applicants reserve the right to further prosecute, without prejudice, claims 38-54.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)-§806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

### **RESPONSE TO PARAGRAPH 6 OF OFFICE ACTION (REQUIREMENT TO ELECT A SINGLE DISCLOSED SPECIES AND DEFINE THE ACTIVE MATERIAL, M AND X):**

Amended Group I has been provisionally elected.

In accordance with 35 U.S.C. 121, alternative chemical ingredients used in a compound need only have a common property useful in the combination claimed. In claim 28, the active material may be a lithiated intercalation compound selected from the group consisting of a

lithium-containing metal oxide and a lithium-containing chalcogenide compound, such as those listed in formulas (2) to (14) in claim 35, whose general characteristics include providing for lithiated intercalation, as is known to those skilled in the art.

With respect to group M, again it is noted that, in accordance with 35 U.S.C. 121, the alternative chemical ingredients used in a compound need only have a common property useful in the combination claimed. Members of the group M are known to those skilled in the art to belong to, and behave substantially in accordance with, a group called "metals." A metal is defined in The Condensed Chemical Dictionary, Tenth Edition, Revised by Gessner G. Hawley, Copyright 1981, page 659, as "An element that forms positive ions when its compounds are in solution and whose oxides form hydroxides rather than acids with water." Claim 2 recites more particularly that M is an element selected from the group consisting of Na, K, Mg, Ca, Sr, Ni, Co, Si, Ti, B, Al, Sn, Mn, Cr, Fe, V, Zr, and a combination thereof.

Similarly, in accordance with 35 U.S.C. 121, the members of the group X are described as elements that are capable of forming a double bond with oxygen. In claim 3, X is described more particularly as an element selected from the group consisting of P, S, W, and a combination thereof. Hence, the common property useful in the combination claimed of the members of the group X is understood by those that are skilled in the art.

Applicants do not wish to limit the present invention, and respectfully submit that claims 1-37 represent a single disclosed genus or species. However, in accordance with the requirement by the Examiner, a single disclosed species elected in accordance with Amended Group I is provisionally selected as a species described in claim 28, an active material for a battery, comprising a lithiated intercalation compound that includes at least one of a lithium-containing metal oxide and a lithium-containing chalcogenide compound, and a surface-treatment layer formed on a surface of the lithiated intercalation compound having a solid-solution compound including Al and P, and an  $\text{AlPO}_k$  (where k is 2 to 4) compound.

#### **CONCLUSION:**

Upon review of references involved in this field of technology, elected claims 1-14 and dependent claims 15-27 and 28-37 are directed to an active material for a battery having a surface treatment comprising a compound of the formula (1):  $\text{MXO}_k$ , wherein M is at least one element selected from the group consisting of an alkali metal, an alkaline earth metal, a group

13 element, a group 14 element, a transition metal, and a rare-earth element, X is an element that is capable of forming a double bond with oxygen, and k is a numerical value in the range of 2 to 4, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, pending claims 1-37 should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, claims 1-37 are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,  
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